REMARKS/ARGUMENTS

Claims 1-20 are rejected and pending. Claims 21-24 have been added to further define the invention. Applicant submits the Amendment above, the Declaration submitted in response to the prior Office Action, and the second Declaration of Alan L. Colquitt overcome the Examiner's rejections and respectfully requests reconsideration and withdrawal of all rejections.

Responsive to the rejection of claims (1-4, 14-17, and 20) and (9-13 and 19) under 35 U.S.C. § 101 as being directed to non-statutory subject matter, Applicants have amended claims 1-4, 14-17, and 20 to recite that the claimed process results in the creation of a printed report, computer file, or display. Specifically, Claim 1 now recites the step of "providing the comprehensive individual capability evaluation to the individual by at least one of a printed report, a computer file, or a display screen" thus providing the concrete, tangible, and useful result. Similarly in Claim 14, there is a concrete, tangible, and useful results produced in the step of "providing the individual action plan document to the individual by at least one of printing the report on paper, saving the report to a computer file, or displaying the report on a display screen." Applicants have previously amended claims 9-13 and 19 to claim a computer readable medium, including operating instructions thereon, which the Examiner has stated would constitute patentable subject matter. It is believed that these amendments overcome the rejections under 35 U.S.C. § 101. Such removal is respectfully requested.

Responsive to the rejection of claims 1-3, 5-7, 9, and 11-13 under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent Publication No. 2002/0045154 to Wood et al., ("Wood") in view of U.S. Patent No. 7,184,969 to Bonstetter et al. ("Bonstetter"), Applicants have amended the claims to clarify the originally presented subject matter and submits the Second Colquitt Declaration. All of the independent claims now make explicit the meaning of the individual capability tests so that the claims explicitly recited that "each of the individual capability tests being a standardized measure of a psychological construct." Further, the cross-referencing step explicitly calls for cross-referencing questions "relating to one of the plurality of attributes."

Neither Wall nor Bonstetter disclose, teach, or suggest the use of multiple tests that are a standardized means of a psychological construct, nor do they disclose, teach, or suggest cross-referencing questions relating to a specific attribute.

The first Colquitt Declaration is relevant because it presents significant evidence of the nonobviousness of the presently claimed invention and refutes the reasonings stated for the rejections. The second Colquitt Declaration further explains the differences between the cited references as one of ordinary skill in the art understands the significance of the claim language, and refutes the conjectures the Examiner stated in the last Office Action. Accordingly, Applicants submit that both Colquitt Declarations provide evidence on the interpretation of the cited prior art and the claims in the present application, and compels the Examiner to withdraw the pending prior art rejections and place the application in a condition for allowance. The Examiner has not met the burden required to continue to reject the claims.

While the Wood and Bonstetter references use many of the words recited in the pending claims, the Colquitt Declarations have presented evidence of the actual meaning of those references. This evidence presented by the Applicants contrasts to the inferences made in the reasoning provided for the present rejections. In paragraph 17 of the last Office Action, the Examiner stated that "Wood does not explicitly disclose ... rating the plurality of competencies of the individual." In paragraph 36, the Examiner stated that he "simply does not see how Wood does not measure competencies." Such reasoning cannot be sustained.

The Patent Examiner's burden for establishing obviousness under the Administrative Procedures Act (APA) has been set forth In Re Zurko, 258 F.3d 1379 (Fed. Cir. 2001) and its progeny. In Zurko, the claim of creating a secure computer environment was rejected by the Examiner as being obvious. The Federal Circuit rejected the Examiner's contention of obviousness based on the following findings: (1) none of the prior art references relied on by the Examiner disclosed one of the limitations in the claimed invention; (2) General conclusions about "basic knowledge" and "common sense" do not remedy deficiencies in the prior art for

showing obviousness. The Federal Circuit took exception with the Examiner's "general conclusions" as not being based on any evidence in the record and stated that the record must reflect "some concrete evidence to support findings of obviousness." (Zurko, 259 USPQ at 1695) Applicant acknowledges the reasoning set forth by the Examiner in setting forth the grounds of rejection, but Applicant respectfully points out that the premises upon which the Examiner has based that reasoning on unsubstantiated assumptions about the knowlege of one of skill in this art.

Of particular similarity to the present situation, another case decided on the Zurko precedent points out the deficiencies in the present rejections. The case of In Re Sang-Su Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Federal Circuit held the record established by the Examiner and the Board did not meet the APA standards for an obviousness rejection. In Sang-Su Lee, the Examiner's rejection was based on two prior art references that purportedly made the Applicant's claim "common sense and common knowledge" to one of ordinary skill in the art if "the proper programming software" was added (Sang-Su Lee, 61 USPQ at 1432). In rejecting the Examiner's contention of obviousness the Federal Circuit held the APA requires a "scheme of reasoned decision making" requiring the agency to articulate the reasons for its decisions by presenting evidence on which it's finding's are based (Sang-Su Lee, 61 USPQ at 1433). The Federal Circuit, relying on McGinley, 262 F.3d 1339, 1351-52 (Fed Cir 2001), held that objective evidence in the record needed to show a teaching, motivation or suggestion to select and combine the references relied on as evidence of obviousness." (Sang-Su Lee, 61 USPQ at 1433). The Court further stated that "motivation can NOT be resolved on subjective belief and unknown authority." (Sang-Su Lee, 61 USPQ at 1432) The Federal Circuit went on to say that an examiner can satisfy the burden of showing obviousness of a combination of prior art "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references." (quoting In re Fritch, 23 USPQ 2d 1780 (Fed. Cir. 1992), Sang-Su Lee, 61 USPQ at 1432.) The Federal Circuit held that "conclusory statements [common knowledge and common

sense] do not fulfill the [Examiner's] obligation" without supporting: (1) objective analysis; (2) proper authority; and (3) reasoned findings. By failing to provide evidence for which to base its conclusion of "common sense and common knowledge" the Federal Circuit concluded that the Examiner has omitted a relevant factor and such action was arbitrary. (Sang-Su Lee, 61 USPQ at 1434) Although the Examiner has presented reasoning, the premises underlying the reasoning have been refuted and thus such reasoning is not supported by proper authority.

The declaration of Colquitt demonstrates that the claimed invention is patentable over the combination of Wood and Bonstetler, and specifically refutes the assumptions the Examiner has stated in explaining his obviousness reasoning. Wood teaches a system that utilizes one or more instruments to measure the system user's characteristics in order to classify the person into a selected personality scheme and to match advice, content and other people with the user based upon the results of the instruments. (Paragraph 45 of Wood). The instruments provide questions to the user to obtain different types of data, including demographic data, psychographic data, personality data (including data that measures cognitive skills and competencies), life style and quality of life data, application specific data, behavioral data, declared preferences data, scenario based testing data and roll play based testing data. (Paragraphs 75 – 168 of Wood). The obtained data is then scored, standardized into alphanumeric representations and compared to personality models so that the user can be classified into a personality scheme. (Paragraph 81 of Wood).

While the personality instruments taught by Wood may be used to obtain data that measures one's skills and competencies, Wood does not disclose, teach or suggest that the instruments may be used to assess a plurality of *attributes* associated with at least one of a plurality of competencies. Combining the competencies of Woods with the testing of attributes by Bonstetter as asserted by the Examiner does not address the cross-referencing of responses related to an attribute claimed in the present invention.

The Wood teaching of multiple tests being "USED IN CONJUCTION" does not disclose, teach, or suggest the present invention's cross-referencing responses related to an attribute. In Woods, there is no explicit disclosure regarding "USED IN CONJUNCTION" and the dictionary definition of this term only speaks of using multiple tests together. Contrast Woods with the present invention, disclosing and claiming cross-referencing wherein the dictionary definition of cross-references is "a notation or direction at one place to pertinent information at another place." (See paragraph 6 of the Colquitt declaration that shows the difference between the relationship defined in Woods and that defined by the present application). Applicants submit that Wood does not include having references from attributes directed to pertinent information at another place on the multiple tests, and therefore Wood does not disclose, teach, nor suggest the cross-referencing of the present invention.

Bonnstetter discloses a system for analysizing individual competencies for matches with potential jobs. Bonnstetter discloses 23 competencies, each of which is the subject of 9 questions, with the answers to the 9 questions enabling the system to rate the particular competency. Bonnstetter lacks any disclosure, teaching, or suggestion of having a plurality of tests relating to attributes of competencies, and cross-referencing responses in relation to the attributes.

Bonstetter does not add any further teaching or suggestion regarding to the pending claims. In particular, Bonstetter does not disclose a plurality of individual capability tests--rather Bonstetter deals with job analysis questionaires. As detailed in paragraph 8 of the Colquitt Declaration, Bonstetter relates to competencies as they relate to job requirements and does not deal with attributes. The combination of Wood and Bonstetter does not teach, suggest, or otherwise render ovbious the claimed invention, see Colquitt Declaration at paragraph 9. Similarly, the grounds of rejection of Claim 2 are refuted in Colquitt Declaration paragraph 10, and the grounds of rejection of Claim 3 are refuted in Colquitt Declaraion paragraph 11.

Responsive to the rejection of claims 4, 8, 10 and 14-20 under 35 U.S.C. 103(a) as being unpatentable over Wood in view of Bonstetter and further in view of U.S. Patent No. 6,341,267 to Taub ("Taub"), Taub adds no further teaching or suggestion regarding the cross-referencing of attribute assessments in creating comprehensive individual capability evaluations. Therefore, Applicants submit that for the reasons stated above relating to the rejection based on Wood and Bonstetter, this rejection has also been traversed. In addition, the first Declaration of Colquitt explains the difference between the intervention planning of Taub and the claimed individual capability evaluation, see the first Colquitt Declaration at paragraphs 18 and 19.

The present invention enables the evaluation of the components of competencies, the constituent attributes, so that relevant attributes may be addressed and the individuals evaluated may be trained in areas to improve those attributes. This allows for individuals to focus on attribute areas, for example those identified in a comprehensive individual capability evaluation, to raise an individual's competencies. In Bonnstetter, an individual is only rated on the gross competency evaluation, with no insight on the component attributes. Thus, the cited prior art references, along or in combination, fail to disclose, teach, or suggest the claimed invention. The Examiner has taken the position that Wood and Bonstetter are sufficiently analogous to the claimed invention. Applicants have provided the evidence of the Colquitt Declarations to refute the position that Wood and Bonstetter (and Taub) render the claimed invnetion obvious.

For all of the above reasons, Applicants submit that claims 1-24 **are in allowable form** thereby placing the application in condition for allowance. Applicants respectfully request allowance thereof.

Should any questions concerning any of the foregoing arise, Examiner is invited to telephone the undersigned at (317) 237-0300.

In the event that Applicants have overlooked the need for an extension of time or a payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully submitted,

s/Kevin R. Erdman/
Kevin R. Erdman, Reg. No. 33,687
Attorney for Applicants
BAKER & DANIELS
300 North Meridian Street
Suite 2700
Indianapolis, IN 46204
Telephone: (317) 237-0300
Fax: (317) 237-1000

Enc. Second Declaration of Alan L. Colquitt
with attachments
Exhibits A-D